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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,645	09/08/2000	Erwann Loret	065691/0199	8835

22428 7590 03/11/2003

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

SAEED, KAMAL A

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/622,645

Applicant(s)

LORET, ERWANN

Examiner

Kamal A Saeed

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Paper No. 13.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 71,74-85 and 87-138 is/are pending in the application.
- 4a) Of the above claim(s) 71- 100 and 117-138 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 101-113 is/are rejected.
- 7) ☒ Claim(s) 114-116 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 . 6) ☐ Other: _____

DETAILED ACTION

Claims 1-71 have been cancelled by amendment filed on June 28, 2002. Claims 72, 73 and 86 have been cancelled by amendment filed on December 3, 2002. Claims 71, 74-85, and 87-138 are pending in this application. Claims 71- 100 and 117-138 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference which anticipates one group would not render obvious the other.

Response to Restriction

Applicant's election with traverse of Group **III**, claims 101-116, drawn to di or trisubstituted triphenyl compound in paper No. 13 is acknowledged. The traversal is on the ground(s) that the restriction requirement did not comport to unity of invention standard. This argument is partially persuasive. Under unity of inventions if the elected compounds are found allowable then the method of use and one method of preparing will be rejoined with the compound, so far as they are limited to the elected subject matter. The remaining groups are properly restricted as the structural moiety common to all groups I-VIII is known in the art and therefore, cannot be said the special technical feature which makes contribution over the prior art. Therefore, the restriction requirement in paper No. 2 is still deemed proper and is made FINAL.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants preserve their right to file a divisional on the non-elected subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections, set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 101-113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steamers et al, *Journal of American Chemical Society* (1995), 117 (37), 9408-14 (CAS ABSTRACT ONLY).

Applicants claim a di- or trisubstituted triphenyl compound, a hydrocarbon substituent of formula $\text{CH}_2\text{A}'\text{F}_a$ wherein $\text{CH}_2\text{A}'$ represent a linear aliphatic chain comprising 1-8 carbon atoms and F_a represent a substituent comprising at least one proton donor or acceptor.

Determination of the scope and content of the prior art (MPEP §2141.01)

Steamers et al, teach triphenyl compounds that have a substituent with two proton acceptors. (See 14 CAS ABSTRACT RN 3 166898-50-6, *Journal of American Chemical Society* (1995), 117 (37), 9408-14).

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Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The compounds of Steamers et al, are analogous to the compounds of this application. One of the difference between the claimed compounds and that of steamers et al herein lie in that in the triphenyl compound is further substituted by methyl group.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

However, alkyl and H are art recognized equivalents. In re Wood, 199 U.S.P.Q. 137 (C.C.P.A. 1978) and In re Lohr, 137 U.S.P.Q. 548, 549 (C.C.P.A. 1963). Therefore, it would have been prima facie obvious to one having ordinary skill in the art at the time the invention was made to substitute alkyl for H, in the compounds of Steamers et al. The motivation to make the claimed compounds derives from the expectation that structurally similar compounds are generally expected to have similar biological and chemical properties. In re Gyurik, 596 F. 2d 1012, 201 USPQ 552 (CCPA 1979).

Claim Objections

Claims 114-116 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamala Saeed whose telephone number is (703) 308-4592. The examiner can normally be reached on Monday-Friday from 8:00 AM – 5:00 PM.

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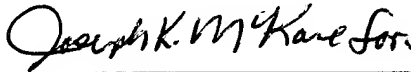
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308 4537. The unofficial fax phone for this group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate the Header (upper right) "Official" for papers that are to be entered into the file, and " Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-2286.

Kamala Saeed, Ph.D.,
March 10, 2003



Celia C. Chang, Ph.D.,
Primary Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1